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TROXELL LAW OFFICE PLLC
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EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/766,830	Applicant(s) CHEN, CHIEN-YUAN	
	Examiner Benjamin E. Lanier	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 3-9, 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 4, 12, recite, "each of the same content," which renders the claim indefinite because it appears that the claim is referring to different content by using the term 'each', however, the term 'same' is also used to describe the content. Therefore, it is unclear from the claims what the SID relationship is with the content. For the purposes of examination, the claims will be treated as meaning that different content has a different identifier.
3. Claims 3-9, 11-16 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.
4. Claims 8, 9, and 16, recite, "inflating memory space into negligible files," which renders the claim indefinite because "inflating" means to make larger while "negligible" means small. Therefore, the idea of inflating memory space into a small measure is indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6-12, 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Hatakeyama, U.S. Patent No. 6,873,975. Referring to claims 1-3, 10, 11, to the extent understood, Hatakeyama discloses a content usage control system where access to content is controlled (Col. 11, lines 62-66) based upon an access control list that specifies, by identification number (Abstract & Col. 10, lines 35-57, 55-66), what physical elements must be present in the user system to access the content (Col. 11, line 67 – Col. 12, line 12). One of the physical elements includes an IC card (Figure 3 & Col. 10, lines 35-57, 55-66), which meets the limitation of a memory card and a control chip, wherein, the control chip further comprising automatic coding system therein, the automatic coding system having a least one SID, the SID protected digital content of the memory card having an automatic coding system therein, while the digital content of the memory card without an automatic coding system not being protected.

Referring to claims 4, 12, as discussed above, Hatakeyama that the each content has an associated serial number (Col. 11, line 3), which meets the limitation of each of the same content of the memory card being individually saved and protected by different SID.

Referring to claims 6, 14, to the extent understood, Hatakeyama discloses that a content storage device, such as the IC card (Col. 17, lines 53-55), can function as the usage environment specifying element (Col. 13, lines 26-30), which specifies what player to use (Col. 8, lines 55-59), which meets the limitation of the memory card applying to a media player, the media player being played directly by the memory card without saving the content having the SID therein the register of the media player.

Referring to claims 7, 15, to the extent understood, Hatakeyama discloses that the id of the IC card is verified against the access control list before the content is played on the player

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(Col. 8, lines 55-59 & Col. 12, lines 1-12), which meets the limitation of the media player checking if conformity with the SID of the memory card before playing, the media player not playing of not conformity therewith.

Referring to claims 8-9, 16, Hatakeyama discloses a content usage control system where access to content is controlled (Col. 11, lines 62-66) based upon an access control list that specifies, by identification number (Abstract & Col. 10, lines 35-57, 55-66), what physical elements must be present in the user system to access the content (Col. 11, line 67 – Col. 12, line 12), which meets the limitation of the control chip further comprising inflation factors, the memory card verifying if the SID of the memory card conforming to hardware being saved, the inflation factors inflating memory space into negligible files if not conformity therewith.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 5, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatakeyama, U.S. Patent No. 6,873,975, in view of How the Internet Works (Gralla)³. Referring to claims 5, 13, Hatakeyama discloses that the content is distributed over an open network (Col. 5, lines 41-42), but does not specify that the open network is the Internet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to distribute the content of Hatakeyama over the Internet because the Internet has become intimately tied to the way we live and work and our means for obtaining content as taught by Gralla (Page 250).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Benjamin E. Lanier